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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/918,326

07/30/2001

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30006788-2

4475

7590 03/04/2008
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EXAMINER

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ART UNIT

PAPER NUMBER

2137

MAIL DATE

DELIVERY MODE

03/04/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH ALEXANDER HARRISON
and RICHARD BROWN

Appeal 2007-3443
Application 09/918,326
Technology Center 2100

Decided: March 4, 2008

Before: JAMES D. THOMAS, ALLEN R. MACDONALD,
and THU A. DANG, *Administrative Patent Judges.*

DANG, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal the Examiner's final rejection of claims 1-16 under 35 U.S.C. § 134(2002). We have jurisdiction under 35 U.S.C. § 6(b)(2002).

A. INVENTION

According to Appellants, the invention is a document printout device for receiving and printing out digital documents. The printout device includes a store of digital certificates, each certificate being associated with

a received digital document, and an audit log including a list of received document entries. Each entry in the list contains a reference to one of the certificates in the store and a unique identifier associated with a received digital document. The device is arranged to carry out an on-line authentication of a received certificate held in the store of received documents or even to carry out a batch of on-line authentications of received certificates held in the store of received documents (Spec., Abstract.)

B. ILLUSTRATIVE CLAIM

Claim 10 is exemplary and is reproduced below:

10. In a facsimile machine adapted for receiving and printing out digital documents, a device comprising:

a store of digital certificates, each certificate being associated with a most recent sender of a received digital document; and

an audit log comprising a list of received document entries, each entry containing a reference to one of the certificates in the store and a unique identifier associated with a received digital document, wherein:

the received digital document and a digital certificate of a most recent sender of the received digital document are received contemporaneously by the facsimile machine; and

the facsimile machine is configured to print the received digital document upon the most recent sender of the received digital document being authenticated.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Mazzagatte	US 6,862,583 B1	Mar. 1, 2005.
Slick	US 7,003,667 B1	Feb. 21, 2006.
Fischer	EP 0386867 B1	Oct. 26, 1994.
Mandelbaum	EP 0671830 A2	Feb. 22, 1995.

Claim 10 stands rejected under 35 U.S.C. § 102(e) over the teachings of Mazzagatte;

Claims 1-4, 9, and 11-16 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mazzagatte and Slick;

Claims 5-7 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mazzagatte, Slick and Fischer; and

Claim 8 stands rejected under 35 U.S.C. § 103(a) over the teachings of Mazzagatte, Slick and Mandelbaum.

We affirm.

II. ISSUES

The issues are whether Appellants have shown that the Examiner erred in finding that:

(A) claim 10 is unpatentable under 35 U.S.C. § 102(e) over the teachings of Mazzagatte;

(B) claims 1-4, 9, and 11-16 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Mazzagatte and Slick;

(C) claims 5-7 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Mazzagatte, Slick and Fischer; and

(D) claim 8 is unpatentable under 35 U.S.C. § 103(a) over the teachings of Mazzagatte, Slick and Mandelbaum.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Mazzagatte

1. Mazzagatte discloses a method for authorizing printout of an image corresponding to print data received. In step S501, the sender submits the print job along with unique identification information contained in a digital certificate, which links the print job to the intended recipient. At step S502, the sender submits the data to be printed and the sending node transmits the data via a secure transmission protocol. The data is received by the print node at step S503 via the secure transmission protocol, and as a consequence, the print job is encrypted and stored by the print node. Upon receiving the data, the print node processes the print data and digital certificate to securely store the print data. In step S504, the print node generates a unique symmetric key utilizing a symmetric encryption algorithm. The print node encrypts the print data, encrypts the symmetric key with the public key of the print node, and stores the encrypted print data in step S505. The print node uses the printer's public key to encrypt the symmetric key. The print node submits print job identification information, the intended recipient identification information, storage location

- information for the stored encrypted print data, and the symmetric key encrypted with the printer's public key, to the print queue at step S506, wherein the print node then waits for the intended recipient to arrive at the print and present the proper authentication information to retrieve the print job (col 8, l. 19 to col. 9, l. 35; Fig. 5).
2. The sender and the intended recipient may be one in the same. That is, the person who sends the print job may intend that he/she be the only person to retrieve the printout from the image forming device (col. 7, ll. 11-27).

Slick

3. Slick discloses a process which allows a receiving device, such as printer 50, to verify the integrity of the symmetrically encrypted data 502. An algorithm is applied to print data 601 to create message digest 610, which is then digitally signed using the private key 560 of the sender. The signed hash is then encrypted and sent to signed hash 612 of data block 600 for transmission to the intended printer where it is used for authentication and integrity verification purposes (col. 13, ll. 9-23; Figs. 5A and 6).

Fischer

4. Fischer discloses a methodology for digitally signing documents in which signatures are generated for computer verification. A digital package is signed with a digital signature 308, and includes a seal 310 associated with the digital signature, and certificate and antecedent

certificates 312 which enable a recipient to prove to his satisfaction that the signature is valid and properly authorized (pg. 17, ll. 21-36; pg. 18, ll. 29-36; Fig. 10).

Mandelbaum

5. Mandelbaum discloses a table 404 listing a header messages which are displayed or printed at fax apparatus 100, wherein each entry contains the time and date of receipt of a digital document (Fig. 4).

IV. PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (citations omitted).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary

indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The *claims* measure the invention. See *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). “[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See *In re Morris*, 127 F.3d 1048, 1053-54 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

“[T]he words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d at 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d at 1313 (Fed. Cir. 2005) (en banc).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). “If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103.” *KSR*, 127 S. Ct. at 1734.

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

V. ANALYSIS

35 U.S.C. § 102(e)

Appellants argue that Mazzagatte does not teach or suggest “that ‘the facsimile machine is configured to print the received digital document upon the most recent sender of the received digital document being authenticated,’ as recited and emphasized above in claim 10” (App. Br. 7-8). Appellants assert that, in Mazzagatte, “even if an individual sends a message, his or her authentication is not checked or authenticated as to whether the individual sent an image to an image forming device” (App. Br. 8).

We disagree. The Examiner’s position as to Mazzagatte disclosing the claimed elements on appeal beginning at page 3 of the Answer and the Examiner’s corresponding responsive arguments beginning at page 11 of the

Answer appear to us to meet all of the limitations required by claim 10 on appeal.

Moreover, the term “most recent sender” cannot be confined to a specific embodiment. Appellants’ claims simply do not place any limitation on what the “most recent sender” is to be, to represent, or to mean, other than that the received digital document is printed upon the most recent sender being authenticated. Appellants’ argument that the intended recipient in Mazzagatte is not a “most recent sender” because “even if an individual sends a message, his or her authentication is not checked or authenticated as to whether the individual sent an image to an image forming device” is not commensurate with the invention that is claimed. That is, Appellants appear to be arguing that Mazzagatte does not disclose that the received digital document is printed *only* upon the most recent sender of the received digital document being authenticated, since not all authenticated recipients in Mazzagatte are the most recent sender, which is not commensurate with the claimed invention.

Mazzagatte discloses that the print job is retrieved upon the intended recipient presenting the proper authentication information (FF 1). In Mazzagatte, the sender and the intended recipient may be one in the same (FF 2). As the Examiner found on page 11 of the Answer, “when the queue contains a single document to be printed, the intended recipient (i.e. the send) being authenticated at the print node would also be the most recent sender.” We agree with the Examiner that the sender/intended recipient that is authenticated to retrieve a print job when the queue contains a single document is the claimed “the most recent sender.” Accordingly, we

conclude that the Appellants have not shown that the Examiner erred in finding that Mazzagatte discloses the claimed elements of claim 10.

As to the other recited elements of claim 10, Appellants provide no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Accordingly, we conclude that the Appellants have not shown that the Examiner erred in rejecting claim 10 under 35 U.S.C. § 102(e).

35 U.S.C. § 103(a)

Claims 1-4 and 9

As to claim 1, Appellants repeat the argument that Mazzagatte does not disclose, teach or suggest printing the received digital document upon the digital certificate of the most recent sender being authenticated (App. Br. 12). As discussed above with respect to claim 10, as the Examiner found on page 11 of the Answer, “when the queue contains a single document to be printed, the intended recipient (i.e. the send) being authenticated at the print node would also be the most recent sender.” We agree with the Examiner that the sender/intended recipient that is authenticated to retrieve a print job when the queue contains a single document is the claimed “the most recent sender.”

As to the other recited elements of claim 1, Appellants provide no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in Mazzagatte and Slick. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claim 1 as unpatentable over Mazzagatte and Slick under 35 U.S.C. § 103(a). At least because Appellants do not provide separate arguments with respect to claims 2-4 and 9 depending therefrom, claims 2-4 and 9 fall with claim 1. We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-4 and 9 under 35 U.S.C. § 103(a).

Claims 5-7

As to claims 5-7, Appellants do not provide a separate argument for claims 5-7, and thus, claims 5-7 fall with claim 1. Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claims 5-7 as unpatentable over Mazzagatte, Slick, and Fischer under 35 U.S.C. § 103(a).

Claim 8

As to claim 8, Appellants do not provide a separate argument for claim 8, and thus, claim 8 falls with claim 1. Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claim 8 as unpatentable over Mazzagatte, Slick, and Mandelbaum under 35 U.S.C. § 103(a).

Claims 11-16

As to claims 11-16, Appellants repeat the argument that Mazzagatte and Slick do not disclose, teach or suggest “printing the received digital document if the certificate of the most recent sender of the received document is authenticated” (App. Br. 15). As discussed above with respect to claims 1 and 10, we agree with the Examiner that the sender/intended

recipient that is authenticated to retrieve a print job when the queue contains a single document is the claimed “the most recent sender.”

As to the other recited elements of claim 11, Appellants provide no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in Mazzagatte and Slick. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claim 11 as unpatentable over Mazzagatte and Slick under 35 U.S.C. § 103(a). At least because Appellants do not provide separate arguments with respect to claims 12-16 depending therefrom, claims 12-16 fall with claim 11. We conclude that Appellant has not shown that the Examiner erred in rejecting claims 11-16 under 35 U.S.C. § 103(a).

CONCLUSIONS OF LAW

(1) Appellants have not shown that the Examiner erred in finding claim 10 unpatentable under 35 U.S.C. § 102(e) over the teachings of Mazzagatte.

(2) Appellants have not shown that the Examiner erred in finding claims 1-4, 9, and 11-16 unpatentable under 35 U.S.C. § 103(a) over the teachings of Mazzagatte and Slick.

(3) Appellants have not shown that the Examiner erred in finding claims 5-7 unpatentable under 35 U.S.C. § 103(a) over the teachings of Mazzagatte, Slick and Fischer.

(4) Appellants have not shown that the Examiner erred in finding claim 8 unpatentable under 35 U.S.C. § 103(a) over the teachings of Mazzagatte, Slick and Mandelbaum.

(5) Claims 1-16 are not patentable.

DECISION

The Examiner's rejection of claim 10 under 35 U.S.C. §102(e) and claims 1-9 and 11-16 under 35 U.S.C. §103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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